

REMARKS

By the present amendment, independent claims 1 and 9 have been amended. Support for these amendments is provided at, for example, paragraph 065 on page 15 of the specification of the present application. Claims 1, 3-10, and 12-14 remain pending and under current examination.

In the Final Office Action dated November 1, 2006, the Examiner took the following actions: rejected claims 1, 3-6, 9,10, and 14 under 35 U.S.C. § 102(b) as being anticipated by International Publication No. WO 97/15009 to Bajpai ("*Bajpai*"); rejected claim 7 under 35 U.S.C. § 103(a) as being unpatentable over *Bajpai* in view of U.S. Patent No. 6,460,070 to Turek et al., ("*Turek*"); rejected claim 8 under 35 U.S.C. § 103(a) as being unpatentable over *Bajpai* in view of U.S. Patent No. 5,111,384 to Aslanian et al., ("*Aslanian*"); rejected claims 12 and 13 under 35 U.S.C. § 103(a) as being unpatentable over *Bajpai* and *Aslanian* further in view of International Publication No. WO 01/18652 A1 to Cha et al., ("*Cha*").

Applicant respectfully traverses each of the rejections presented in the November 1, 2006 Final Office Action and requests allowance of the present application in view of the following remarks.

I. Rejection under 35 U.S.C. § 102(b)

Applicant traverses the rejection of claims 1, 3-6, 9, 10, and 14 under 35 U.S.C. § 102(b) as being anticipated by *Bajpai*. Applicant respectfully disagrees with the Examiner's arguments and conclusions.¹

In order to properly establish anticipation under 35 U.S.C. § 102, the Federal Circuit has held that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). *See also* M.P.E.P. § 2131.

Bajpai does not disclose each and every element of the claims, despite the Examiner's allegations.

For example, with respect to independent claim 1, *Bajpai* fails to disclose the claimed "first and second auxiliary systems" wherein the first and second auxiliary systems are "adapted to forward, to the service system, preliminary solutions based on the auxiliary knowledge representations when a problem is escalated to the service system." The Examiner alleges that *Bajpai* teaches the claimed "first and second auxiliary systems" based on the expert system 30 shown in Figure 2. (Final Office Action, page 2, lines 14-15). Further, the Examiner asserts that *Bajpai* discloses the

¹The Office Action may contain statements characterizing the related art, case law, and claims. Regardless of whether any such statements are specifically identified herein, Applicants decline to automatically subscribe to any statements in the Office Action.

escalation of a problem to the claimed “service system” based on the description of contacting a remote processor at page 9, ll. 19-27. (Final Office Action, page 3, lines 6-8). Applicant respectfully disagrees.

The portion of *Bajpai* cited by the Examiner states, in part: “[i]n many cases the expert system 30 of the local diagnostic element 28 will not find a solution to a problem...In these cases, the local diagnostic element 28 contacts a the [sic] remote diagnostic element” (*Bajpai*, page 9, ll. 19-24). Therefore, it is clear that in *Bajpai*, the expert system contacts the remote diagnostic element only when it does not find a solution. In contrast, claim 1 requires that the first and second auxiliary systems do more than contact the service system, but also forward “preliminary solutions based on the auxiliary knowledge representations.”

Further, the portion of *Bajpai* cited by the Examiner states: “[i]n addition, the local expert system 30 can request that the remote diagnostic element download new files, e.g. software updates or new problem solution databases. (*Bajpai*, page 9, ll. 26-27). This does not constitute forwarding “preliminary solutions based on the auxiliary knowledge representations”, as required by claim 1. Requesting that the remote element download a file (software updates, problem solution databases, etc) does not constitute forwarding “preliminary solutions” as required by claim 1. Accordingly, the rejection to claim 1 under 35 U.S.C. § 102(b) should be withdrawn.

Still further, *Bajpai* does not teach the ability to “identify a first set of search results,...forwarding the...first set of search results to a second expert system, wherein ... the first set of search results comprise preliminary solutions to the problem”, as

required by independent claim 9. The Examiner alleges that *Bajpai* teaches this at page 10, ll. 3-9, which lists the type of information passed from the local diagnostic element to the remote diagnostic element. The list includes configuration files, and “[i]t also includes information gathered by the local diagnostic element (e.g., directly from the user or via the instrumentation) regarding the symptoms and characteristics of the specific problem to be solved.” (*Bajpai*, page 10, lines 7-9, emphasis added). However, this does not constitute, “forwarding the...first set of search results to a second expert system” wherein the search results comprise “preliminary solutions” as required by claim 9 (emphasis added). *Bajpai* does not disclose identifying and then forwarding search results as claimed. In fact, *Bajpai* specifically states, as mentioned previously, that, “[i]n many cases the expert system 30 of the local diagnostic element 28 will not find a solution to a problem...In these cases, the local diagnostic element 28 contacts a the [sic] remote diagnostic element”, (*Bajpai*, page 9, ll. 19-24, emphasis added). Therefore, contrary to the Examiner’s allegations, *Bajpai* does not teach forwarding a “first set of search results” where those results include “preliminary solutions based on the auxiliary knowledge representations.” Consequently, the rejection to claim 9 under 35 U.S.C. § 102(b) should also be withdrawn.

Claims 3-6, 10, and 14 depend from claims 1 or 9 and, therefore, require all elements thereof. As set forth above, *Bajpai* fails to teach each and every element of claims 1 and 9. Therefore, the rejection of claims 3-6, 10, and 14 under 35 U.S.C. § 102(b) is improper.

II. Rejections under 35 U.S.C. § 103(a)

Applicant respectfully traverses the rejections of claims 7, 8, 12, and 13, under 35 U.S.C. § 103(a) because no *prima facie* case of obviousness has been established. As M.P.E.P. § 2142 states, “[t]he Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.”

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). M.P.E.P. § 2142, 8th Ed., Rev. 5 (August 2006), p. 2100-125, 126.

Each of these requirements must “be found in the prior art, and not be based on applicant’s disclosure.” M.P.E.P. § 2143.

Here, no *prima facie* case of obviousness has been established for at least the reason that the cited references fail to teach or suggest each and every element of claim 1, from which the rejected claims depend. In particular, *Turek*, *Aslanian*, and *Cha* fail to cure the noted deficiencies of *Baipai*. That is, *Turek*, *Aslanian*, and *Cha*, fail to teach or suggest the claimed “first and second auxiliary systems” wherein the first and second auxiliary systems are “adapted to forward, to the service system, preliminary solutions based on the auxiliary knowledge representations when a problem is escalated to the service system,” as required by claim 1. Therefore, *Baipai*, *Turek*,

Aslanian, and *Cha*, when taken alone or in any combination, fail to establish a *prima facie* case of obviousness with respect to dependent claims 7, 8, 12, and 13 and the 35 U.S.C. § 103 rejections should be withdrawn.

CONCLUSION

In view of the foregoing remarks, Applicant submits that the claims are neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicant, therefore, requests the Examiner's reconsideration and reexamination of the application and the timely allowance of the pending claims.

Applicant respectfully requests that this amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 1, 3-10, and 12-14 in condition for allowance. Applicant submits that the proposed amendments of claims 1 and 9 do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this amendment should allow for immediate action by the Examiner.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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